

REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated May 11, 2009.

Claim Rejections - 35 USC § 102

The Applicant has been unable to understand fully the relevance of the passage of Wellner cited by the Examiner in the recent Office Action.

The passage cited by the Examiner states *inter alia* that:

In step 302, the user swipes the paper with the pen 11, which senses marks on the paper. In step 302a, the pen 11 may optionally store the mark information for later transmission to interface 15. In step 303, as previously described, these marks may be interpreted within the pen 11 before the information is transmitted to interface 15 or, to reduce the cost of the pen, the pen 11 may send raw scanning information to the interface 15 for processing. In

All this passage is saying is that the pen swipes the paper and transmits information to a computer system. The information may be raw scanning information or it may be interpreted by the pen before transmission.

This passage is supposed to be relevant to the claim feature of:

“indicating data ... indicative of a position of a nib of the pen relative to the form”

However, the passage of Wellner cited by the Examiner says nothing whatsoever about the *position* of a nib of the pen. The “mark information” could be any information; there is nothing in Wellner teaching that the “mark information” is indicative of the position of the pen. In fact, the only part of Wellner teaching as to what sort of information is actually contained in the “mark information” is provided at column 2, lines 28-42 of Wellner. Column 2, lines 28-42 clearly teaches the skilled person that the mark information is multimedia information. There is no teaching in Wellner, either in the passage cited by the Examiner or anywhere else, that the “mark information” is indicative of a *position* of the nib.

Notwithstanding the above, the Examiner then goes on to allege that the following claim feature is also taught by the cited passage of Wellner:

“wherein the position of the nib is computed using an observed perspective distortion on an imaged tag and a known geometry of pen optics”

The Examiner’s interpretation of one passage of Wellner has confounded the Applicant. The Applicant cannot even attempt to determine where this claim feature is to be found in Wellner. There is no mention or hint of the use of perspective distortion to compute a nib position. Accordingly, the Applicant submits that there is no basis for the Examiner’s rejection under 35 USC 102 in view of Wellner, and the Applicant therefore requests that the finality of the recent Office Action be withdrawn.

The Examiner also alleges that the Applicant’s previously filed arguments extend beyond the scope of the claims. The Applicant denies this allegation. In his previous response, the Applicant merely argued that the claim feature of “wherein the position of the nib is computed using an observed perspective distortion on an imaged tag and a known geometry of pen optics” provides an advantage in terms of improving the accuracy of positional information. This feature is not taught by Wellner, neither does Wellner suggest any advantage in making such a modification.

It is not the job of the patent claims to recite each and every advantage afforded by a claimed apparatus or method. Rather, it is the job of patent claims to define clearly the scope of an invention. Whether or not a particular claimed method achieves a particular advantage or result does not in any way affect the scope of that method. This was confirmed in *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) where it was held that a “‘whereby’ clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited”. Thus, even if the Applicant had included a clause in claim 1, such as “whereby the calculation of the nib position improves positional accuracy”, it should not be given any patentable weight by the Examiner. All the necessary steps for achieving improved positional accuracy are already recited in claim 1. A “‘whereby’ clause describing the intended result of the claimed method neither changes the scope of claim 1, nor is it necessary to define the scope of the invention. Accordingly, the Applicant submits that his previously-filed arguments are entirely consistent with the scope of claim 1.

After consideration of these submissions, the Examiner is requested to withdraw the rejection under 35 USC 102 and, further, withdraw the finality of the recent Office Action.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,



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